

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Initially, Applicants would like to thank the Examiner for the indication that claims 1-6 and 9-16 are allowed and claim 8 as containing allowable subject matter.

In the Official Action, the Examiner objects to the drawings under 37 C.F.R. § 1.83(a) because the drawings do not show the holding means engaging with the tightening ring. Furthermore, the Examiner argues that it is unclear what is meant in Claim 33 by the holding means being a step, which engages the tightening ring.

In response, Applicants respectfully submit that the holding means engaging with the tightening ring is shown in Figures 23A and 23B of the drawings. Furthermore, claim 33 has been amended to clarify that "said clip comprises arms and said holding means is a stepped section that is provided at each of the arms of said clip, and is engaged with said tightening ring." Accordingly, it is respectfully requested that the objection to the drawings under 37 C.F.R. § 1.83(a) be withdrawn.

In the Official Action, the Examiner objects to claim 38 because the phrase "said clip an be elastically" on line 2 thereof has a misspelling. In response, claim 38 has been amended to correct the misspelling. Accordingly, it is respectfully requested that the objection to claim 38 be withdrawn.

In the Official Action, the Examiner rejects claims 7, 8, 26, and 32 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner objects to certain grammatical and antecedent errors in the claims. In response, claims 7, 26, and 32 have been amended. Claim 8 has also been amended to clarify the same.

Accordingly, it is respectfully requested that the rejection of claims 7, 8, 26, and 32 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In the Official Action, the Examiner rejects claims 17-22, 25, 28-30, and 34 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,766,189 to Matsuno (hereinafter "Matsuno"). The Examiner also rejects claim 34 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,402,765 to Monassevitch et al. (hereinafter "Monassevitch"). Furthermore, the Examiner rejects claims 32 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Matsuno in view of U.S. Patent No. 5,207,692 to Kraus et al. (hereinafter "Kraus"). Lastly, the Examiner rejects claims 34-40 under 35 U.S.C. § 103(a) as being unpatentable over Matsuno in view of Monassevitch.

In response, independent claims 17, 28, and 34 have been amended to clarify their distinguishing features.

Regarding independent claims 17 and 28, Matsuno discloses an openable/closeable clip 2, a tightening ring 4, a link member 3, and an opening wire 13. However, according to Matsuno, the hook portion 3A indicated by the Examiner engages the clip 2 with the coupling plate 3 in the clip unit 1. In contrast, in claim 17 of the present application, a deformable link member or a deformable hook (corresponding to the clip 2 or the hook portion 3A) defines the structure of the part that engages the clip unit with the clip-operating device. As a result, the tissue clipping apparatus of claim 17 of the present application makes it easier to engage the clip unit with the clip-operating device by an engagement structure that utilizes elastic deformation and restoration of shape.

In contrast, Matsuno does not disclose the structure recited in claim 17 of the present application nor is Matsuno directed to the same objective as the present invention, namely, to make the engagement between the clip unit and the clip-operating device easier.

Moreover, Matsuno discloses an engagement structure achieved by deciding the positions of the pin 15 and the opening 3f of the clip 2, relatively moving the pin 15 and the opening 3f of the clip 2 in the axial direction of the operating wire and in a direction perpendicular to the axial direction of the operating wire, and then engaging the pin 15 and the opening 3f of the clip 2 along the axial direction of the opening wire. Such an engagement structure is difficult to accomplish.

As recited in claim 17 of the present application, holding means for temporarily maintaining the opened state when the arms of the clip are opened to the maximum is provided. The holding means can comprise the stepped sections provided to the arms of the clip, the step of the tightening ring, and the protrusions of the coupling member. In contrast, Matsuno discloses that the opened state is temporarily maintained when the arms of the clip are opened to the maximum by adjusting the inner diameter of the tightening ring, and unlike the present application, does not disclose holding means.

Claim 17 has been amended to emphasize these distinguishing features. Specifically, independent claim 17 has been amended to recite that the clip unit includes a link member "capable of being inserted into the tightening ring and engaged with the clip, thereby transferring a force that retracts the clip into the tightening ring to the clip," and a clip operating device separable from the clip unit which includes "a hook capable of being engaged with the link member of the clip unit" and "an operating wire transferring the force that retracts the clip into the tightening ring to the hook." Furthermore, independent claim 17

has been further amended to clarify that at least one of the link members and the hook "is elastically deformable, the link member and the hook define an engagement structure wherein based on deformation and restoration of shape of one of the link member and the hook, the one of the link member and the hook is engaged with the other one of the link member and the hook and the clip unit is engaged with the clip operating device by the engagement structure."

Furthermore, independent claim 28 has been amended to recite that the link member is engaged with the clip, "thereby transferring a force that retracts the clip into the tightening ring to the clip" and a holding means for, "stopping the clip from being further retracted into the tightening ring when the clip is opened to the maximum, thereby temporarily maintaining the opened state." Claim 28 has been further amended to recite that "the holding means has a holding force that permits release of the clip from the opened state when the clip is pulled, after the opened state is maintained, with a force greater than the force used to retract the clip until the clip is opened to the maximum."

Regarding claim 34, Monassevitch discloses a clip 170 made of superelastic metal. However, the clip 170 is a helical body and therefore differs in structure from the clip of the present invention. Claim 34, as amended, recites that the clip is "made into a V-shape by bending a central portion of the clip" which is not shown in either Monassevitch or Matsuno. In addition, Monassevitch merely discloses a clip and does not in any way disclose the combined structure of a clip, a tightening ring, and a link member as is recited in independent claim 34.

Claim 34 also stands rejected as being unpatentable over the combination of Matsuno and Monassevitch. However, as recited in amended claim 34, the clip is made of openable/closeable superelastic alloy and is made into a V-shape by bending the central

portion of the clip. Neither Matsuno nor Monassevitch disclose or suggest such a clip configuration.

The amendments to claims 17, 28, and 34 are fully supported in the original disclosure. Therefore, no new matter is being entered into the disclosure by way of the amendments to independent claims 17, 28, and 34.

Regarding claims 32 and 33, Kraus discloses that steps 70, 74 are provided to the clip to restrict the opening amount. In addition to claims 32 and 33 depending from an allowable base claim (28), the clip of Kraus differs in structure from the clip of the present invention.

With regard to the rejection of claims 17-22, 25, 28-30, and 34, under 35 U.S.C. §§ 102(b) and 102(e), a physiological tissue clipping apparatus having the features discussed above and recited in amended independent claims 17, 28, and 34, is nowhere disclosed in either Matsuno or Monassevitch. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”¹ independent claims 17, 28, and 34 are not anticipated by either Matsuno or Monassevitch. Accordingly, independent claims 17, 28, and 34 patentably distinguish over both Matsuno and Monassevitch and are allowable. Claims 18-22, 25, and 29-30 being dependent upon claims 17 and 28, are thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejections of claims 17-22, 25, 28-30, and 34 under 35 U.S.C. §§ 102(b) and 102(e).

With regard to the rejection of claims 32 and 33 under 35 U.S.C. § 103(a), since independent claim 28 patentably distinguishes over the prior art and is allowable, claims

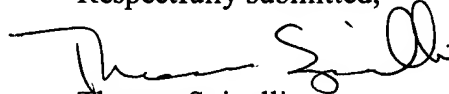
¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

32 and 33 are at least allowable therewith because they depend from an allowable base claim. Furthermore, as discussed briefly above, claims 32 and 33 patentably distinguish over Matsuno and Kraus independently of their base claim (28).

With regard to the rejection of claims 34-40 under 35 U.S.C. § 103(a), Independent claim 34, as amended, is not rendered obvious by the cited references because neither the Matsuno patent nor the Monassevitch patent, whether taken alone or in combination, teach or suggest a physiological tissue clipping apparatus having the features discussed above. Accordingly, claim 34, as amended, patentably distinguishes over the prior art and is allowable. Claims 35-40, being dependent upon claim 34, are thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 34-40 under 35 U.S.C. § 103(a).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Thomas Spinelli

Registration No.: 39,533

Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, New York 11530
(516) 742-4343

TS:cm